

**IN THE U.S. PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of	Appeal No.
Richard CHENE et al.	Conf. 2965
Application No. 10/509,994	Group 3679
Filed October 5, 2004	Examiner Nahid AMIRI

SYSTEM OF ARTICULATION, ESPECIALLY FOR EQUIPMENT USED IN ROBOTICS
AND FOR SPECTACLE FRAMES

APPEAL BRIEF

MAY IT PLEASE YOUR HONORS:

1. Real Party in Interest

The real parties in interest in this appeal are:

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2. Related Appeals and Interferences

None.

3. Status of Claims

Claims 16-20, 23-25 and 27 are pending. Claims 23-25 and 27 have been withdrawn. Claims 1-15, 21, 22, 26 and 28 have been canceled. Claims 16-20 stand rejected, from whose final rejection this appeal is taken.

4. Status of Amendments

A preliminary Amendment (entered) was filed on October 5, 2004, which canceled original claims 1-15 and entered new claims 16-28.

A non-final Amendment (entered) was filed on December 20, 2006, which amended claims in response to a non-final Office Action mailed September 25, 2006.

A non-final Amendment (entered) was filed on September 6, 2007, which amended claims in response to the non-final Official Action mailed June 6, 2007.

A final Official Action was mailed November 27, 2007 finally rejecting claims 16-20, from which this appeal is taken.

An after-final Amendment was filed on April 25, 2008, which presented claim amendments that would instantly overcome issues under 35 USC §112. This amendment was refused entry per the Advisory Action mailed July 8, 2008.

5. Summary of Claimed Subject Matter

Independent claim 16: As is set forth in independent claim 16, the present invention pertains to a spectacle frame having a side-piece 7, 8 and a spectacle face 7, 8 (page 6, lines 1-3, page 8 lines 7-14) interconnected by including at least one pivot point P1, P2 (page 3, lines 6-9, page 7, lines 6-15) between one end of the side-piece 7, 8 and an end of the spectacle face 7, 8 (page 3, lines 17-18). The ends have bearing faces 33, 34, 35, 36 fit for pairing up respectively one on top of the other (page 9, lines 10-12 and 25-27), and elastic means 18, 31 for maintaining the bearing contact between said faces ("means" limitation, page 9, lines 16-20), wherein the spectacle frame includes two pivot parts 2, 3, 4 (page 7, lines 29-32), each having a recessed zone 5 (page 7, line 34) limited by an at least partially curved surface 6 (page 3, lines 15-17, page 7, lines 34-35), each of the pivot parts 2, 3, 4 depending respectively on one of the side-piece 7, 8 and spectacle face 7, 8 (page 3, lines 17-18), the pivot 2, 3, 4 parts being substantially orthogonal to each other (page 3, lines 18-19, page 7, lines 16-22), and engaged one in the other through interlocking of their respective recessed zone 5 (page 3, lines 20-21), thereby to be able to pivot relative to each other (page 3, lines 21-22), with the result that the system includes two intangible pivot points P1, P2 movable in the two orthogonal planes (page 3, lines 11-14, page 7, lines 16-22) of the pivot

parts 2, 3, 4 within the limits permitted by the recessed zones 5, and means which allow pivoting only in one or two predetermined planes ("means" limitation, page 3, lines 6-10, page 7, lines 23-28).

It is noted that 35 USC § 112, sixth paragraph was not invoked during the prosecution of the application.

6. Grounds of Rejection to be Reviewed on Appeal

The first ground for appeal is whether claims 16-20 have been properly rejected under 35 USC §112, second paragraph as being indefinite.

The second ground for appeal is whether claims 16-20 have been properly rejected under 35 USC §103(a) as being unpatentable over MORTON (U.S. Patent 1,674,983) in view of WARSHAWSKY (U.S. Patent 4,492,488).

7. Arguments

7.1 First Ground: Rejection Under 35 USC 112, Second Paragraph

The preliminary Amendment of October 5, 2004 presented new claim 16, which had the preamble: "A system of articulation." The Amendment of September 6, 2007 amended the preamble of claim 1 to read: "A spectacle frame."

The Official Action of November 27, 2007 asserts that the limitation "said system" in claim 16 lacks antecedent basis.

However, it is clear that the limitation "said system" in claim 16 refers to the spectacle frame recited in the preamble.

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said system", where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference.

However, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006) (holding that "anode gel" provided by implication the antecedent basis for "zinc anode"); *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid").

Also, inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that

mathematically an inherent characteristic of an ellipse is a major diameter").

In this case, one of ordinary skill would recognize that the limitation "said system" in claim 16 refers to the spectacle frame set forth in the preamble. This would especially pertain given a knowledge of the history of claim 16.

One of ordinary skill would thus find claim 16 to be clear and definite, and thus within the aegis of 35 USC §112.

This rejection for indefiniteness should accordingly be withdrawn.

7.2. Second Ground: Rejection of Claims 16-20 under 35 USC §103(a) over MORTON in view of WARSHAWSKY

7.2.1 Interpretation of 35 USC §103

When a rejection is based on 35 USC §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. See *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In

determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 USC §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reasoning must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact

that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

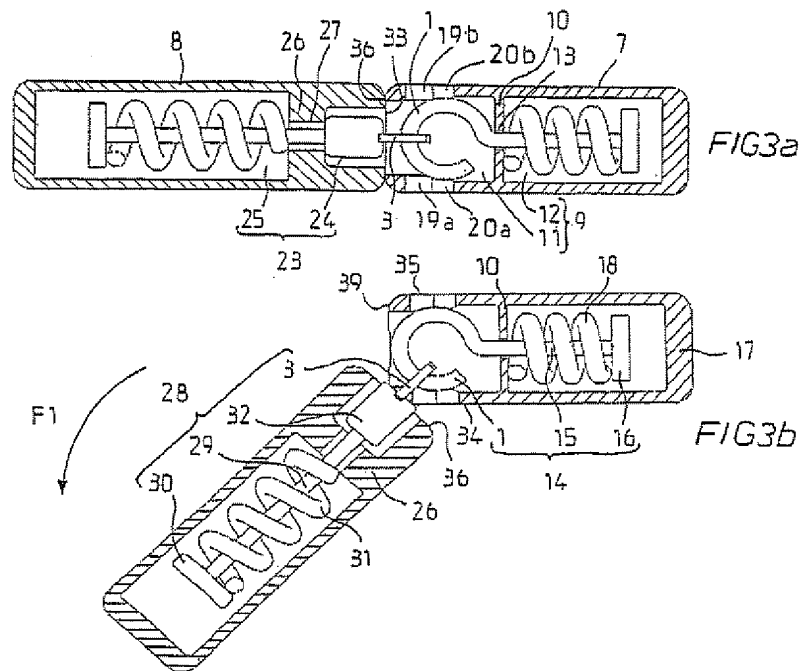
The criteria for patentability has been refined by the by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), 550 U.S. ___, 82 USPQ2d 1385 (2007). The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (*Id.* at ___, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (*Id.*); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try'" (*Id.*); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (*Id.*).

Although the Supreme Court in *KSR* cautioned against an

overly rigid application of teaching-suggestion-motivation (TSM) rationale, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness. (According to the Supreme Court, establishment of the TSM approach to the question of obviousness "captured a helpful insight." 550 U.S. at ___, 82 USPQ2d at 1396 (citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 207-208 (1961)).

7.2.2 The Present Invention

The present invention pertains to a spectacle frame that can be pivoted in only two predetermined planes. The present invention is illustrated, by way of example, in Figures 3a and 3b of the application, which are reproduced below.

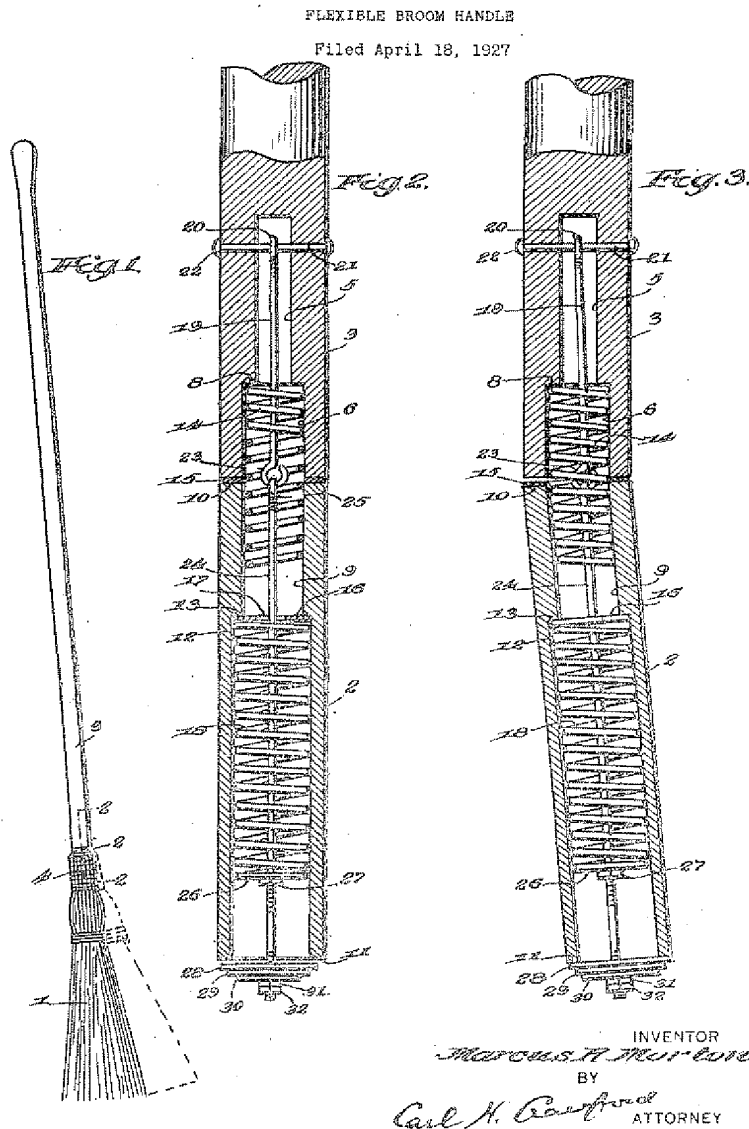


Figures 3a and 3B show a hook 1 and plate 3 having an opening (which can also be a ring). Bearing faces 33-36

facilitate movement of the moving element 8 in respect to the fixed element 7. Claim 16 of the present invention recites "means which allow pivoting only in one or two predetermined planes."

7.2.3 MORTON and WARSHAWSKY

MORTON pertains to a flexible broom handle such as is depicted in Figures 1-3, which are reproduced below.



The drawing figures of MORTON show a broom handle sections 2, 3, springs 14, 18, an eye 23 and a washer 15.

MORTON fails to disclose any technology pertaining to a spectacle frame. Nonetheless, the Official Action of November 27, 2007 at page 3, line 3 asserts: "Morton discloses a spectacle frame . . ."

However, MORTON is clearly non-analogous art.

See, e.g., *Stevenson v. International Trade Comm.*, 612 F.2d 546, 550, 204 USPQ 276, 280 (CCPA 1979) ("In a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into other areas where one of ordinary skill in the art would be aware that similar problems exist."). See also *In re Bigio*, 381 F.3d 1320, 1325-26, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004). The patent application claimed a "hair brush" having a specific bristle configuration. The Board affirmed the examiner's rejection of the claims as being obvious in view of prior art patents disclosing toothbrushes. 381 F.3d at 1323, 72 USPQ2d at 1210. The applicant disputed that the patent references constituted analogous art. On appeal, the court upheld the Board's interpretation of the claim term "hair brush" to encompass any brush that may be used for any bodily hair, including facial hair. 381 F.3d at 1323-24, 72 USPQ2d at 1211. With this claim interpretation, the court applied the "field of endeavor test" for analogous art and determined that the references were within the field of applicant's endeavor

and hence was analogous art because toothbrushes are structurally similar to small brushes for hair, and a toothbrush could be used to brush facial hair. 381 F.3d at 1326, 72 USPQ2d at 1212.

However, the Examiner has put forth no reasons as to why a person of ordinary skill in the spectacle frame art would turn to the teachings of broomstick technology.

That is, the examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed. " *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.

However, the Examiner has performed no such determination, but rather analyzes MORTON using the broad misstatement that "Morton discloses a spectacle frame . . ."

The Official Action of November 27, 2007 at page 3, lines 13-14 acknowledges at least one of the failures of MORTON, stating: "The articulation system of Morton does not include a means allowing pivoting only in one or two predetermined planes."

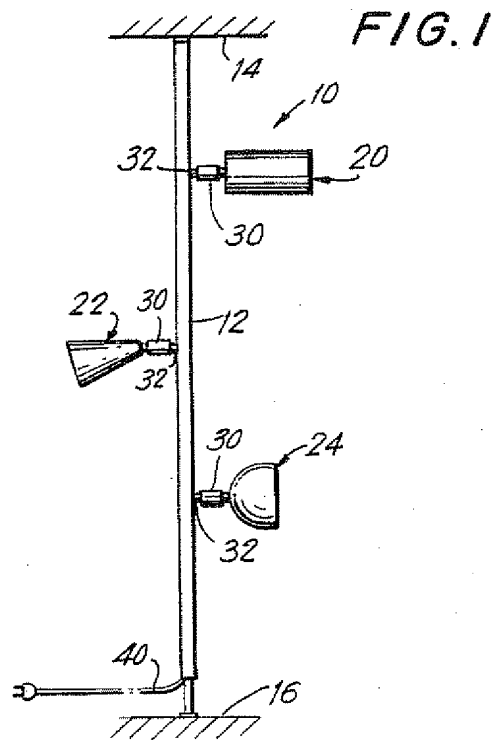
In contrast, claim 16 of the present invention specifically sets forth that the spectacle from includes means that allow pivoting only in one or two predetermined planes.

The Official Action of November 27, 2007 at page 3, lines 14-15 then asserts: "However, it is well-known in the art per se to limit the plane of pivoting whenever universality of pivoting is not desired. Washawsky is evidence of this."

WARSHAWSKY pertains to a lamp swivel, which is also non-analogous art to spectacle frames.

WARSHAWSKY discloses a lamp swivel which permits a lamp unit to be pivoted about two axis X and Y which intersect at 90° (column 4, lines 18-19 and lines 30-32), through the combination of two different mechanisms: one part (swivel 80) rotates around axis X and is prevented to rotate except about axis X (column 3 lines 27 and lines 33-34) and one part (tailpiece 120) rotates about axis Y almost at 360°. As a result, the lamp unit can be brought in any plane resulting from the combination of the 0-90° rotation about axis X and 0-360° about axis Y.

WARSHAWSKY aims to have a rotation in a multiplicity of planes but he cannot obtain such a rotation by using a single mechanism due to the electric conductor wire 40 which extends through connecting members 32, swivel assemblies 30 and the light sockets of lamp units (column 2, lines 59-65). This can be readily seen in Figure 1 of WARSHAWSKY, which is reproduced below.

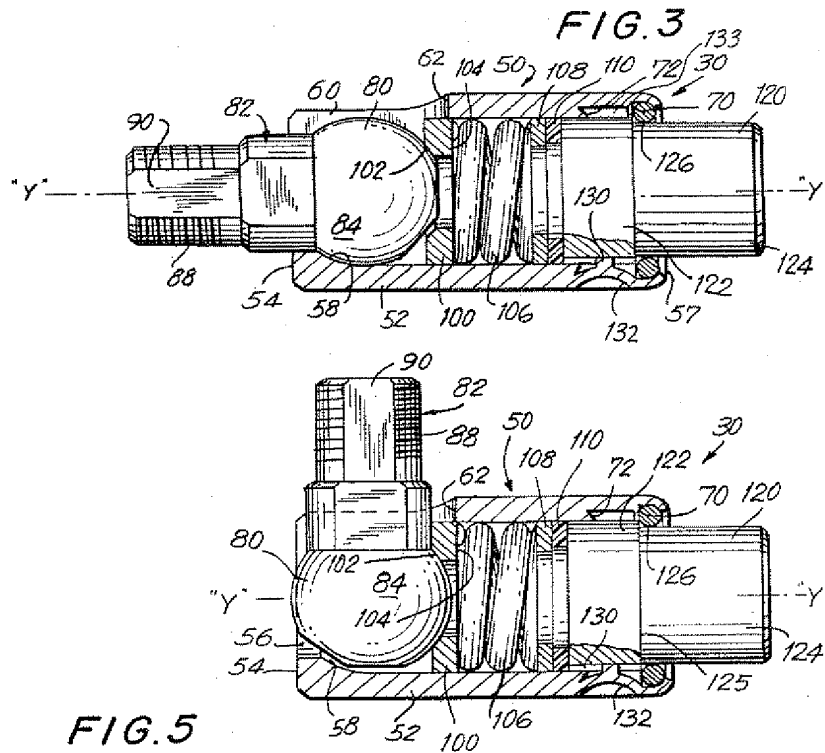


In contrast, the present invention avoids such rotation in a multiplicity of planes, which can be two predetermined planes.

Furthermore, WARSHAWSKY fails to disclose a two-part device interconnected one pivot point between one end of one part and one end of the other part, the ends having bearing faces fit for pairing up one on top of the other, with elastic means maintaining the bearing contact between said faces, as claimed in claim 16.

WARSHAWSKY does show elastic means (spring 106) which bears, through washer 62, against swivel ball 84 to bias it against portions of the inner wall of part 54, but swivel ball 64

and the portions of inner wall of part 54 cannot be considered as "ends having bearing faces fit for pairing up one on top of the other." See Figures 3 and 5 of WARSHAWSKY, reproduced below.



One of ordinary skill and creativity would thus fail to produce claim 16 of the present invention from a knowledge of the non-analogous art of MORTON and WARSHAWSKY (assuming that one of ordinary skill would even turn to this art). A *prima facie* case of unpatentability over claim 16 has thus not been made. Claims depending upon claim 16 are patentable for at least the above reasons.

The unpatentability rejection of claims 16-20 should thus be withdrawn.

8. Conclusion

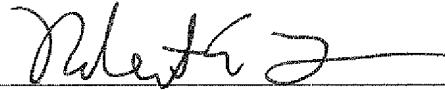
The Appellants have demonstrated that the Examiner has failed to successfully allege that the rejected claims are indefinite or *prima facie* unpatentable. It is clear that the inventive spectacle frame represents a truly inventive technology. For the reasons advanced above, it is respectfully submitted that claims 16-20 are allowable. Thus, favorable reconsideration and reversal of the Examiner's rejections of claims 16-20 under 35 USC §§112/103, by the Honorable Board of Patent Appeals and Interferences, are respectfully solicited.

Please charge any additional Appeal Brief fee, if required, to Deposit Account No. 25-0120.

Respectfully submitted,

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Enclosures: Claims Appendix
Evidence Appendix
Related Proceedings Appendix

9. Claims Appendix

16. (previously presented) A spectacle frame having a side-piece and a spectacle face interconnected by comprising at least one pivot point between one end of the side-piece and an end of the spectacle face, said ends having bearing faces fit for pairing up respectively one on top of the other, elastic means for maintaining the bearing contact between said faces, wherein said system comprises two pivot parts, each having a recessed zone limited by an at least partially curved surface, each of said pivot parts depending respectively on one of the side-piece and spectacle face, said pivot parts being substantially orthogonal to each other, and engaged one in the other through interlocking of their respective recessed zone, thereby to be able to pivot relative to each other, with the result that said system comprises two intangible pivot points movable in the two orthogonal planes of said pivot parts within the limits permitted by said recessed zones, and means which allow pivoting only in one or two predetermined planes.

17. (previously presented) The spectacle frame as claimed in claim 16, wherein said pivot parts take the form of a ring, a loop, a hook or a polygonal plate, having a recess limited by an at least partially curved surface.

18. (previously presented) The spectacle frame as claimed in claim 16, wherein the at least partially curved surface limiting the recessed zone of each of the pivot parts is circular.

19. (previously presented) The spectacle frame as claimed in claim 16, wherein at least one of the ends of said side-piece and spectacle face incorporates a receptacle, open on the articulation side and provided with a tie rod, one end of which is held captive in said receptacle and the other end of which constitutes one of said pivot parts, said elastic means cooperating with said tie rod in order to force the bearing faces of said side-piece and spectacle face to remain in contact one with the other.

20. (previously presented) The spectacle frame as claimed in claim 16, wherein at least one of the ends of said side-piece and spectacle face incorporates a receptacle, open on the articulation side, and the wall of said receptacle has at least one axial notch, the geometry and size of which allow a pivot part portion to penetrate into said notch from the open end of said receptacle.

10. Evidence Appendix

None.

11. Related Proceedings Appendix

None.